

## REMARKS

### I. Introduction

Claims 1-76 are pending.

Claims 1-76 were rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Fries U.S. Patent No. 6,317,885 ("Fries") in view of Goodhand et al. U.S. Patent No. 5,923,848 ("Goodhand"), the "Fries-Goodhand Combination."

Claims 1-76 were rejected under 35 U.S.C.

§ 102(e) as being unpatentable over Schein et al. U.S. Patent Publication No. US 2003/0005445 A1 ("Schein").

These rejections are respectfully traversed.

### II. Applicants' Reply To The Rejections Under 35 U.S.C. § 103(a)

Claims 1-76 were rejected under 35 U.S.C.

§ 103(a) as being unpatentable over the Fries-Goodhand Combination. However, applicants respectfully submit that, for the reasons set forth in detail below, the Office Action has failed to establish a *prima facie* case of obviousness and the § 103 rejections should therefore be withdrawn. See MPEP §§ 2142 and 2143.

#### A. The Fries-Goodhand Combination Fails to Show or Suggest Allowing Users to Order E-mail Reminder Messages

Applicants' system and method of independent claims 1 and 20 generally relate to providing e-mail reminders for an Internet television program guide. As set forth in independent claims 1 and 20, "a web server provid[es] . . . web pages of television program listings

over the Internet" to a user's multimedia system. The user is provided with an opportunity to select a television program listing and to "order at least one *e-mail* reminder message" for the selected television program listing. E-mail reminder messages are sent "over the Internet *via e-mail*" to remind the user when the selected television program is to be broadcast. Dependent claims 2-19 and 21-76 include additional patentable features.

The Office Action contends that Fries discloses a web server configured to allow a user to order "a reminder message for [a] television program" in the table of column 33. See page 3 of the Office Action. However, the specified table merely indicates that user-specific data may be stored in a set-top box and used for various functions (e.g., a user's name and address may be used to electronically order tangible goods to be delivered to the user's address). This section of Fries fails to show or suggest allowing a user to "order at least one *e-mail* reminder message" as specified by applicants' claims 1 and 20.\* Nothing in Goodhand compensates for this deficiency in Fries, and the Office Action fails to address whether this feature of applicants' claims is even shown in the prior art.

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\* Applicants acknowledge that Fries shows a reminder call function ("REMIND") in the table at column 18, which broadly indicates that reminders may (in some unspecified way) be set for television programs. However, Fries remains silent on allowing users "to order at least one *e-mail* reminder" as specified in applicants' claims 1 and 20.

Instead, the Office Action merely concludes (in response to applicants' previously filed arguments') that:

. . . it is extremely well known in the networking art as already shown by Fries-Goodhand and Schein and other prior art of record disclosed, for users in an Internet television programming environment to be reminded through the use of e-mail of specific televised programs through the Internet as well as other claimed features of applicants' invention.

See page 19 of the Office Action. However, the Office Action fails to indicate where this precise feature of applicants' claims is shown by the prior art. Moreover, by conceding that "Fries remains silent on the specific teachings of *e-mail* for transport of reminder messages" (see page 3 of the Office Action), it is unreasonable for the Office Action to contend that Fries shows or suggests allowing a user to "order at least one *e-mail* reminder message" as specified by applicants' claims 1 and 20.

For at least the foregoing reasons, applicants respectfully submit that the § 103 rejections be withdrawn. See In re Royka, 490 F.2d 981 (CCPA 1974); see also MPEP § 2143.03.

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\* Applicants respectfully submit that the Office Action fails to address applicants' previously filed argument stating that the sections of Fries and Goodhand relied upon by the Examiner fail to show or suggest allowing a user to "*order at least one e-mail reminder message*" as specified by applicants' claims 1 and 20. See page 5 of applicants' Preliminary Remarks Accompanying Applicants' Request for Continued Examination filed September 17, 2003.

B.    The Fries-Goodhand Combination Fails to  
      Show or Suggest Sending E-mail Reminder  
      Messages Over the Internet Via E-mail

The Office Action acknowledges that Fries "remains silent on the specific teachings of e-mail for transport of reminder messages" and attempts to fill this admitted gap with disclosure found at column 25, line 67 - column 26, line 23 of Goodhand. See page 3 of the Office Action. However, this section of Goodhand simply shows that existing e-mail messages may be "flagged" and that reminders for the flagged messages may be generated *locally* by the e-mail system at a predetermined period of time prior to a due date associated with the message (e.g., using a computer processor to compare the due date data for each message with the given time).\*

Goodhand thus fails to show or suggest "send[ing] the e-mail reminder message over the Internet via e-mail" as specified by applicants' claims 1 and 20, and nothing in Fries compensates for this deficiency in Goodhand.\*\* For at least this reason, applicants respectfully request that the § 103 rejections be withdrawn. See In re Royka, 490 F.2d 981 (CCPA 1974); see also MPEP § 2143.03.

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\* Again, the Office Action has failed to specifically address this argument as previously provided by applicants. See page 5 of applicants' Preliminary Remarks Accompanying Applicants' Request for Continued Examination filed September 17, 2003.

\*\* Indeed, Goodhand adds nothing to the disclosure of Fries except to suggest that an electronic mail system may implement techniques for reminding users of specific events (e.g., emails).

C.    The Office Action Fails to Provide a  
      Sufficient Motivation for Making the Fries-  
      Goodhand Combination

In response to applicants' previously presented arguments, the Office Action acknowledges that "obviousness can only be established by combining or modifying the teaching of the prior art . . . where there is some teaching, suggestion or motivation found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." However, instead of providing such an objective teaching, suggestion, or motivation, the Office Action merely concludes that "Fries already utilizing well known teaching of e-mail notification, would have also looked into the field of e-mail notification **to further enhance** the system by allowing for e-mail notification for specific events." See pages 18-19 of the Office Action. The Office Action further indicates that "since Fries does provide for a system for receiving e-mail notification as well as reminders for specific events the motivation to combine the two references is met." See pages 3-4 of the Office Action.

The motivation fails, however, because it is grounded in the unreasonable conclusion that one skilled in the art would have used features that are already broadly described in Fries without any relation whatsoever (i.e., e-mail notifications and reminders for specific events) to further modify Fries to "**enhance the system**," such that it achieves the precise effect of applicants' claimed approach (which is neither shown nor suggested by the disclosure of Fries). Because applicants' specification remains the only objective evidence of record that would have led one skilled in the art "to further enhance" the Fries system to

arrive at applicants' claimed approach, applicants respectfully request that the § 103 rejections be withdrawn. See In re Dembiczak, 175 F.3d 994 at 999; see also In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002) ("it is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher").

Indeed, the motivation provided by the Office Action fails because it lacks any objective basis whatsoever: the Office Action fails to indicate any objective authority that would have provided one skilled in the art with the required reason or motivation "to further enhance" Fries and arrive at applicants' claimed approach. It is well-settled that the factual question of a motivation to combine references must be "based on objective evidence of record" and "cannot resolved on subjective belief and unknown authority" such as that provided by the Office Action. See In re Lee at 1342; see also In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[b]road, conclusory statements standing alone are not 'evidence' of a motivation to combine"). For at least this reason, applicants respectfully request that the § 103 rejections be withdrawn.

### III. Applicants' Reply To The Rejections Under 35 U.S.C. § 102(e)

Claims 1-76 were rejected under § 102(e) as being anticipated by Schein. Schein generally relates to an electronic television program guide system that allows users to access a remote database via the Internet. See Abstract. The Office Action contends that "Schein

discloses [applicants'] invention substantially as claimed." See page 16 of the Office Action. Specifically, the Office Action states that FIGS. 19A, 19B, 19C, and page 13, paragraph 139 of Schein show "an Internet television program guide e-mail reminder system . . . [that] allows the user to order at least one e-mail reminder message to the multimedia system over the Internet via e-mail to remind the user when that television program is to be broadcast." See *id.*

However, FIG. 19A of Schein shows that a user of an interactive television program guide may access e-mail messages from a program guide menu. FIG. 19B of Schein shows that the program guide may present a list of personal e-mails. FIG. 19C shows the text of an e-mail that relates to services available from the provider of the television program guide. Page 13, paragraph 139 of Schein describes FIGS. 19A, 19B, and 19C, broadly disclosing that a television viewer may use the television program guide to accept incoming e-mail messages and send outgoing e-mail messages.

Applicants' claims 1 and 20, however, patentably improve upon the guide-based e-mail features provided by Schein by allowing the user to "order at least one e-mail reminder message" for a selected television program listing and "send[ing] the e-mail reminder message over the Internet via e-mail." For at least this reason, the § 102 rejections should be withdrawn.

IV. Conclusion

The foregoing demonstrates that claims 1-76 are patentable over Schein and the Fries-Goodhand Combination. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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